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EXAMINER

BOVEJA, NAMRATA

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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/899,206	Applicant(s) KOGA ET AL.	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3-12, 14-20, 22-25 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 13, 21, 26-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/06/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to communication filed on 05/01/2007.
2. Claims 3-12, 15-19 and 22-25 have been withdrawn. Claims 14, 20, and 30 have been cancelled. Claims 1, 2, 13, 21, 26-29, and 31 are presented for examination.
3. Amendments to the claims have been entered and considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claims 1, 2, 13, 21, and 26-28, are rejected under 103(a) as being unpatentable over Bendinelli et al (Patent Number 6,061,719 hereinafter Bendinelli) in view of Sitnik (Patent Number 6,160,570 hereinafter Sitnik).*

In reference to claim 1, Bendinelli teaches an information providing system comprising: an information providing means having means for storing a customer information data representing attributes of a customer (i.e. storing data regarding sites of interest to the customer) (col. 5 lines 50-54), means for generating a first information data reflecting a pre-determined advertisement (i.e. does the customer want to continue seeing the pre-determined advertisement) (col. 4 lines 45-67 and col. 5 lines 50-54), means for generating a customer-specific advertisement data (i.e. customer views the advertisement of interest and the

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ongoing display of advertisements is stopped) (col. 4 lines 45-67) based at least in part, on said customer information data (i.e. data regarding sites of interest to the customer) (col. 5 lines 50-54) and said first information (i.e. the customer selects to continue viewing a particular advertisement) (col. 4 lines 45-67), and including a communication address corresponding to said customer (i.e. an embedded URL in the television signal for display on a different window) (col. 6 lines 31-39), a first information transfer path (i.e. television program sent via an antenna, a cable network, or a satellite receiver) (col. 5 lines 7-13) for transmitting said first information data to a plurality of destinations, and a second information transfer path for transmitting said customer-specific advertisement data to a destination based on said communication address (*column 2 lines 24-30 and column 6 lines 31-39*) (*which disclose that when a tuner card is used, the television picture is displayed in one window on the computer and the URL and webpage are displayed in another window, and therefore, the set top box would need to have the communication address of the computer on which to show this information on in different windows. Even in general, when a person watches a pay per view movie from a set top box, the cable company needs to know the destination address where this programming will be sent, so Bendinelli's set top box can provide the destination address where the video should be sent and the set top box can provide the address of a computer where the information can be displayed*); and an information receiving terminal constructed and arranged to receive said first information data and said customer-specific advertisement data via said first and second information transfer paths respectively (i.e. a television

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or computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11), wherein said first information transfer path, and said second information transfer paths are different from one another (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11).

Bendinelli does not teach attributes of a customer including at least one from the group consisting of the customer's age, customer's nationality, and customer's gender. Sitnik teaches attributes of a customer including at least one from the group consisting of the customer's age (col. 1 lines 58 to col. 2 lines 4), customer's nationality, and customer's gender (col. 1 lines 58 to col. 2 lines 4). It would have been obvious to modify Bendinelli to include customer attributes such as the customer's age and gender to allow for better customer targeting for advertisers.

5. In reference to claims 2 and 21, Bendinelli teaches an information providing system, method, and code comprising: a first information providing means and code for transmitting to a plurality of destinations via a first information transfer path, a first information data reflecting a pre-determined advertisement (i.e. television program sent via an antenna, a cable network, or a satellite receiver) (col. 5 lines 7-13); a second information providing means and code having means for storing a customer information data representing attributes of a customer (i.e. storing data regarding sites of interest to the customer) (col. 5 lines 50-54), and having means for generating and transmitting, via a second information transfer path, customer-specific advertisement data having a destination address corresponding to said customer (column 2 lines 24-

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30 and column 6 lines 31-39) (which disclose that when a tuner card is used, the television picture is displayed in one window on the computer and the URL and webpage are displayed in another window, and therefore, the set top box would need to have the communication address of the computer on which to show this information on in different windows. Even in general, when a person watches a pay per view movie from a set top box, the cable company needs to know the destination address where this programming will be sent, so Bendinelli's set top box can provide the destination address where the video should be sent and the set top box can provide the address of a computer where the information can be displayed), said customer-specific advertisement data based, at least in part, on said customer information (i.e. data regarding sites of interest to the customer) (col. 5 lines 50-54) and on said first information (i.e. the customer selects to continue viewing a particular advertisement) (col. 4 lines 45-67); and an information receiving terminal accessible by said customer, constructed and arranged to receive said first information data via said first information transfer path and said customer-specific advertisement data via said second information transfer path (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11), wherein said first information path and said second information path are different from one another (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11).

Bendinelli does not teach attributes of a customer including at least one from the group consisting of the customer's age, customer's nationality, and customer's gender. Sitnik teaches attributes of a customer including at least one

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from the group consisting of the customer's age (col. 1 lines 58 to col. 2 lines 4), customer's nationality, and customer's gender (col. 1 lines 58 to col. 2 lines 4). It would have been obvious to modify Bendinelli to include customer attributes such as the customer's age and gender to allow for better customer targeting for advertisers.

6. In reference to claim 13, Bendinelli teaches an information providing method, comprising: storing a customer data representing attributes of a customer (i.e. storing data regarding sites of interest to the customer) (col. 5 lines 50-54); transmitting advertisement data via a first information transfer path (i.e. television program sent via an antenna, a cable network, or a satellite receiver) (col. 5 lines 7-13), and a customer-specific advertisement data based on said advertisement data and said customer data and having a destination address corresponding to said specific customer via a second information transfer path (column 2 lines 24-30 and column 6 lines 31-39) (which disclose that when a tuner card is used, the television picture is displayed in one window on the computer and the URL and webpage are displayed in another window, and therefore, the set top box would need to have the communication address of the computer on which to show this information on in different windows. Even in general, when a person watches a pay per view movie from a set top box, the cable company needs to know the destination address where this programming will be sent, so Bendinelli's set top box can provide the destination address where the video should be sent and the set top box can provide the address of a computer where the information can be displayed); and receiving said

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advertisement data and said customer-specific advertisement data first information and said second information via said first and second information transfer paths respectively at an information receiving terminal associated with said customer (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11), wherein, said transmitting of said advertisement is to a plurality of customers and said transmitting of said customer-specific advertisement is, in accordance with said destination address, to said information receiving terminal (i.e. information is sent to the television or computer), and wherein said first information transfer path, and said second information transfer path are different from one another (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11).

Bendinelli does not teach attributes of a customer including at least one from the group consisting of the customer's age, customer's nationality, and customer's gender. Sitnik teaches attributes of a customer including at least one from the group consisting of the customer's age (col. 1 lines 58 to col. 2 lines 4), customer's nationality, and customer's gender (col. 1 lines 58 to col. 2 lines 4). It would have been obvious to modify Bendinelli to include customer attributes such as the customer's age and gender to allow for better customer targeting for advertisers.

7. In reference to claim 26, Bendinelli teaches the information providing system, wherein the first information providing means includes a broadcasting system (i.e. an antenna, a cable network, or a satellite receiver) (col. 5 lines 7-13) and said second information providing means is an information management

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center (i.e. a network) (col. 3 lines 57-col. 4 lines 8 and col. 5 lines 63 to col. 6 lines 11).

8. In reference to claim 27, Bendinelli teaches the information providing system, wherein the first information transfer path is a wireless media (i.e. a satellite receiver) (col. 5 lines 7-13) and the second information transfer path includes a wired network (col. 3 lines 57-col. 4 lines 8 and col. 5 lines 63 to col. 6 lines 11).

9. In reference to claim 28, Bendinelli teaches the information providing system, further comprising means for said customer to send a response request for said customer-specific advertisement data to wherein said second information providing means (i.e. customer can select a particular URL using a keyboard, mouse, and a remote control) (col. 4 lines 45-67 and col.5 lines 54-57), and wherein said means for generating and transmitting said customer-specific advertisement data transmits said customer-specific advertisement data in response to receiving said response request (i.e. customer can view the selected advertisement and stop the ongoing display of advertisements) (col. 4 lines 45-67).

10. Claims 29 *and* 31 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Bendinelli in view of Grapes.

In reference to claim 29, Bendinelli teaches the information providing system (col. 3 lines 57-col. 4 lines 8, col. 5 lines 7-13, and col. 5 lines 63 to col. 6 lines 11) further comprising: means for said customer to send a response request, via said second transfer path for said customer-specific advertisement

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data to said second information providing means, and for including with said response request a data identifying said customer and identifying said pre-determined advertisement (i.e. customer can select to view a specific advertisement and stop the ongoing display of advertisements) (col. 4 lines 45-67). Bendinelli does not teach the system comprising evaluation means for sending reward data to said customer based, at least in part, on said customer sending said response request via said second information transfer path.

Grapes teaches evaluation means for sending reward data to said customer based, at least in part, on said customer sending said response request via said second information transfer path (i.e. data is evaluated regarding customer and transaction history and coupons are issued to influence purchasing) (abstract, col. 8 lines 13-16, col. 9 lines 1-14, col. 14 lines 41-44 and 51-53, and col. 15 lines 14-18). It would have been obvious to modify Bendinelli to include evaluation means for sending reward data to said customer based, at least in part, on said customer sending said response request via said second information transfer path in order to enable advertisers to provide incentives to customers for buying their advertised products.

11. In reference to claim 31, Bendinelli teaches the information providing system further comprising: means for said customer to send a viewing response data identifying receipt of said advertisement data (i.e. the customer can select an advertisement by clicking on it with a mouse, a keyboard, or with a remote, and the list of the selected advertisements can be stored on the set-top box) (col. 5 lines 50-57); means for collecting a database of said viewing response data

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(i.e. a list of advertisements clicked on by the customer is maintained in the set-top box) (col. 5 lines 50-54). Bendinelli does not teach a means for analyzing said viewing response data to generate an evaluation data representing statistics of customer viewing of said pre-determined advertisement. Grapes teaches a means for analyzing said viewing response data to generate an evaluation data representing statistics of customer viewing of said pre-determined advertisement (col. 8 lines 13-16, col. 9 lines 8-13, and col. 14 lines 39-48). It would have been obvious to modify Bendinelli to include a means for analyzing said viewing response data to generate an evaluation data representing statistics of customer viewing of said pre-determined advertisement in order to enable advertisers to evaluate and analyze relevant markets and the customer response rate to advertisements.

Response to Arguments

12. After careful review of Applicant's remarks/arguments filed on 05/01/2007, the Applicant's arguments with respect to claims 1, 2, 13, 21, 26-29, and 31 are presented for examination and have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have been entered and considered.

13. The previously made rejections under 35 USC § 112 have been removed in view of the amendment by applicant.

14. Applicant argues that Bendinelli lacks structure and functions meetings the broadest reasonable meaning of Applicant's claim elements and their recited arrangement for performing the function of storing customer information. The

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Examiner respectfully disagrees with the Applicant, since with regards to this, first of all the preamble in claim 1 states an information providing means having means for storing customer information data, and this is a very broad claim, and the set top box in Bendinelli or any processor can fit this requirement of an information providing means for storing customer information data, i.e. websites visited by the customer. Furthermore, in the Applicant's figure 5, it is illustrated that the user terminal can receive an input by a remote control, and in a set top box, you can receive input, (i.e. a channel selection), entered in by the user through the use of a remote control. Therefore, the set top box is capable of receiving input and storing customer information, and meets the functional and structural requirements of the Applicant's claimed invention.

15. The Applicant argues that Bendinelli's set-top box and decoder do not transmit any customer specific advertisement based on, or to a destination based on, "a destination address (or) customer address corresponding to said customer." Applicant further states that in Bendinelli, URL's are sent as text to the user's television, and if the user enters a command, the browser visits the corresponding webpage and sends the content to only the user's computer or television. First of all, the claim destination or customer address, and hence does not mean multiple addresses or an address different than the customer address. The Examiner additionally respectfully disagrees and would to point to column 2 lines 24-30 and column 6 lines 31-39 which disclose that when a tuner card is used, the television picture is displayed in one window on the computer and the URL and webpage are displayed in another window, and therefore, the

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set top box would need to have the communication address of the computer on which to show this information on in different windows. Even in general, when a person watches a pay per view movie from a set top box, the cable company needs to know the destination address where this programming will be sent, so Bendinelli's set top box can provide the destination address where the video should be sent and the set top box can provide the address of a computer where the information can be displayed.

16. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through


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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

NB

June 25th, 2007


RETTA YEHDEGA
PRIMARY EXAMINER